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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/886,887 | 06/21/2001 | Levi J. Perea JR. | 1710391 | 6120 |
| 24240 | 7590 | 03/16/2004 | EXAMINER | |
| CHAPMAN AND CUTLER 111 WEST MONROE STREET CHICAGO, IL 60603 | | | TRINH, MINH N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3729 | 3 |
| DATE MAILED: 03/16/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/886,887

Applicant(s)

PEREA ET AL.

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to a portable lightweight hand tool, classified in class 29, subclass 749.
 - II. Claims 12-22, drawn to a portable hand tool injection molded, classified in class 29, subclass 751.
 - III. Claims 23-25, drawn to a portable hand tool provided for applying a two-part connector, classified in class 29, subclass 750.
 - IV. Claims 26-32, drawn to a small portable hand tool, classified in class 29, subclass 755.

i. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II, III, or IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case for examples: a) invention II has separate utility such as for applying an electrical connector having a plurality of insulation displacing conductor elements to an insulated electrical cable having a plurality of color wires, and for connecting the two parts of the frame to permit aligned manual relative between parts (see claim 12, lines 1-6); b) invention III has separate utility such as for applying two part electrical connector . . . etc., (see claim 23, lines 1-5), c) invention IV has separate utility such as the second part of the frame having a

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wire insertion end including a plurality of aligned color coded grooves for receiving the color coded wires to be placed into the connector, etc., (see claim 26, lines 7-8).

Furthermore, invention I has its own utility such as for applying an insulation piercing electrical connector to an insulated cable having a plurality of wires (see claim 1, lines 1-2). See MPEP § 806.05(d).

ii. The inventions are distinct, each from the other because of the following reasons:

Inventions II and III, or IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case for examples: a) invention III has separate utility such as for applying two part electrical connector . . . etc., (see claim 23, lines 1-5), b) invention IV has separate utility such as the second part of the frame having a wire insertion end including a plurality of aligned color coded grooves for receiving the color coded wires to be placed into the connector, etc., (see claim 26, lines 7-8). See MPEP § 806.05(d).

iii. The inventions are distinct, each from the other because of the following reasons:

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as the second part of the frame having a wire insertion end including a plurality of aligned color

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coded grooves for receiving the color coded wires to be placed into the connector, etc., (see claim 26, lines 7-8). See MPEP § 806.05(d).

*For at least above reasons, Inventions I-IV are related as subcombinations disclosed as usable together in a single combination because they have different modes of operation, different functions, or different effects (as discussed above).

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not necessary required for Group II, restriction for examination purposes as indicated is proper.

3. A telephone call was made to Mr. Robert J Schneider on 3/15/2004 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Minh Trinh
Examiner Group 3729

mt